



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,672	06/19/2000	James Hongxue Wang	11302-0601 (KC 15,993)	3961

29843 7590 11/14/2002

JOHN S. PRATT
KILPATRICK STOCKTON LLP (KIMBERLY CLARK)
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 11/14/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/595,672

Applicant(s)

WANG ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1713

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. **The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As far as the Examiner can tell and without any guidelines from applicant as to where support might be found, no support can be found for the newly added limitation "and other conventional melt processing techniques" per claim 13 and this, as such, engenders a New Matter situation.**

Claim Rejections - 35 USC § 112

3. **The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

A) The recited "one or more types of monomers" per claims 1-4, 6, 7 and 12-14 constitutes indefinite subject matter as per it not being readily ascertainable as to if or how said objectionable term "types" further limits the claims.

B) The recited "one or more vinyl monomers" per claim 2, "one or more polar vinyl monomers" per claims 3, 4, 12 and 13 and "one or more hydroxyalkyl esters" per claim 6 constitutes indefinite subject matter as per the recited "one or more" engendering superfluous subject matter. It is suggested that applicant delete "one or more" prefacing each of "vinyl

Art Unit: 1713

monomers", "polar vinyl monomers" and "hydroxyalkyl esters" so as to engender claim language clarity.

C) The recited "conventional melt processing techniques" per claim 13 constitutes indefinite subject matter as per the metes and bounds of such engender an indeterminacy in scope.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.**
- 2. Ascertaining the differences between the prior art and the claims at issue.**
- 3. Resolving the level of ordinary skill in the pertinent art.**
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.**

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sumi et al(U.S. 4,140,668) or Miyamoto et al(U.S. 5,430,090) in combination with Ray-Chaudhuri et al(U.S. 3,891,584).

Sumi et al and Miyamoto et al disclos hot melt adhesive compositions, suitable for paper making such as bookbinding, wherein said compositions are defined basically as containing a polyvinyl alcohol-governed melt mixture wherein, components of the polyvinyl alcohol-governed melt mixture are melt blended. See, e.g., the Abstract and the Runs of each of Sumi et al and Miyamoto et al and especially col. 8, lines 13-17 of Sumi et al and col. 5, lines 5-10 of Miyamoto et al wherein the use of other commonly used additives in hot melt adhesive compositions are highly invited. The disclosures of each of Sumi et al and Miyamoto et al differ basically from the claimed invention as per the non-express guidelines to incorporate, into the hot melt adhesive blend compositions, a graft copolymer of poly(ethylene oxide), as claimed.

Ray-Chaudhuri et al teach similar such hot melt adhesive compositions, useful in bookbinding, and defined basically as containing a graft copolymer of a poly(ethylene oxide)-governed melt mixture. See, e.g., the Abstract, the paragraph bridging cols. 2-3, cols. 3-6, especially col. 6, lines 22-43 and the Runs of Ray-Chaudhuri et al. Therefore, it would have been obvious to the skilled artisan to add the graft copolymer of poly(ethylene oxide) of Ray-Chaudhuri et al to the polyvinyl alcohol-governed melt mixture of Sumi et al or Miyamoto et al and with a reasonable expectation of obtaining the cumulative, additive effect. By the same token, it would have been obvious to the skilled artisan to add the polyvinyl alcohol component of Sumi et al or Miyamoto et al to the hot melt adhesive composition of Ray-Chaudhuri et al and with a reasonable expectation of obtaining the cumulative additive effect. Criticality for such, fully commensurate in scope with the claimed invention, not having been demonstrated on this record. It is well established that no patentable invention resides in combining old ingredients of known properties. The combination of two compositions, each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition that is used for the very same purpose is prima facie obvious as authorized by In re Kerkh ven(205 USPQ 1069, CCPA 1980).

Art Unit: 1713

Response to Arguments

9. ***Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.***

10. ***The indication of allowability of claims 1-14 over the prior art of record per the previous Office Action of paper no. 9, 05/21/02, paragraph no. 3 is herein regrettably rescinded based on the newly discovered prior art. An apology is extended to applicants for any inconvenience that this may have caused.***

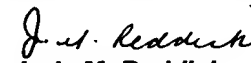
Conclusion

11. ***Note the attached FORM PTO-892 for additional prior art cited as of being illustrative of the general state of the art.***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
November 13, 2002